

### **REMARKS**

Applicant has carefully reviewed and considered the Office Action mailed on October 1, 2003, and the references cited therewith.

Claims 10 and 20 are amended, no claims are canceled, and no claims are added; as a result, claims 10-26 are now pending in this application. Claim 10 has been amended solely to correct a typographical antecedent basis issue.

### **Information Disclosure Statement**

Applicant submitted an Information Disclosure Statement and a 1449 Form on August 1, 2001 and a Supplemental Information Disclosure Statement and a 1449 Form on August 7, 2001. Applicant respectfully requests that initialed copies of the 1449 Forms be returned to Applicants' Representatives to indicate that the cited references have been considered by the Examiner.

### **Affirmation of Election**

Restriction to one of the following claims was required:

As provisionally elected by Applicants representative, David Peterson, on September 23, 2003, Applicant elects to prosecute the invention of Group II, claims 10-26.

The claims of the non-elected invention of Group I, claims 1-9, 27 and 28, are hereby canceled without prejudice or disclaimer. However, Applicant reserves the right to later file continuations or divisions having claims directed to the non-elected inventions.

### **§102 Rejection of the Claims**

Claims 10-15, 19, and 20-22 were rejected under 35 USC § 102(b) as being anticipated by Rapoport (U.S. Patent No. 5,598,845)

The rejection states that Rapoport discloses “an alignment device where it guides insertion of surgical tools through the guiding tube 28 as shown in figures 5-7.” The rejection further states that, “movement of the insertion guide is achieved via detachable swivel mechanism or actuator with adjustable joint 25.”

Rapoport appears to show a swivel joint 25 mounted in rotatable gear 26 which is in turn mounted in rotatable gear 27. Rapoport further appears to show a motor 31 and a motor 34 used to power various gears. However, actuated movement in Rapoport is limited to control of a lateral location of joint 25 over a surface of a patient. *Alignment* of the guide tube 28 in Rapoport is done manually (col. 7, lines 43-47). Rapoport does not show a control module in remote communication with the actuator and in communication with the tissue imaging device, the control module **aligning the insertion axis** with the target location.

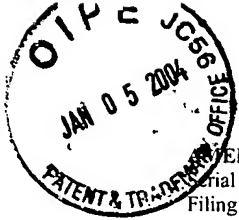
In contrast, claim 10 includes a control module in remote communication with the actuator and in communication with the tissue imaging device, the control module aligning the insertion axis with the target location. Further in contrast, claim 20 includes remotely actuating the actuator to adjust alignment of the insertion axis within the range of motion.

Because the Rapoport reference does not show every element of Applicant's independent claims, a 35 USC § 102(b) rejection is not supported. Reconsideration and withdrawal of the rejection is respectfully requested with respect to Applicant's independent claims 10 and 20. Additionally, reconsideration and withdrawal of the rejection is respectfully requested with respect to the remaining claims that depend therefrom as depending on allowable base claims.

### §103 Rejection of the Claims

Claims 16 and 17 were rejected under 35 USC § 103(a) as being unpatentable over Rapoport (U.S. Patent No. 5,598,845) as applied to claims 1- and 13 above, and further in view of Truwit (U.S. Patent No. 5,993,463). Claims 18 and 23-26 were rejected under 35 USC § 103(a) as being unpatentable over Rapoport (U.S. Patent No. 5,598,845) as applied to claims 10 and 13 above, and further in view of Lee et al. (U.S. Patent No. 3,893,449).

Applicant respectfully submits that the additional references of Truwit, and Lee fail to cure the deficiencies of Rapoport as outlined above. Because the cited references, either alone or



AMENDMENT AND RESPONSE UNDER 37 CFR § 1.111  
Serial Number: 09/825786  
Filing Date: April 4, 2001  
Title: ROBOTIC TRAJECTORY GUIDE

Page 9  
Dkt: 723.035US1

in combination, do not show every element of claims 16-18, and 23-26, a 35 USC § 103(a) rejection is not supported by the references. Reconsideration and withdrawal of the rejection is therefore respectfully requested with respect to claims 16-18, and 23-26.

Conclusion

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney ((612) 373-6944) to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743


Respectfully submitted,

GERALD W. MILLS ET AL.

By their Representatives,


SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
P.O. Box 2938  
Minneapolis, MN 55402  
(612) 373-6944

Date 12-31-03

By   
David C. Peterson  
Reg. No. 47,857

RECEIVED  
JAN 07 2004  
TECHNOLOGY CENTER R3700

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 31st day of December, 2003.

Patricia A. Hultman   
Name Signature